

Appl. No. 09/855,062
Response Dated April 30, 2004
Reply to Office action of February 5, 2004.

REMARKS

Applicant's counsel thanks Examiner Garg for his continued careful and thorough examination of the present application. New independent claim 41 has been added to more clearly describe the invention. No new matter has been entered; basis for the new claim language in claim 41 can be found in the specification at page 6, lines 22-28. All other claims remain as previously pending.

In the last Office action (Paper No. 18), the Examiner construed the transitional phrase "consisting essentially of" in the independent claims 1 and 38 as equivalent to "comprising." To arrive at this construction, the Examiner argued that the specification for the instant application fails to "explicitly point out the exclusion of any element/step or ingredients." Further, the Examiner has asserted that the claim limitation "the following steps in the following order" is not supported by the disclosure.

Having thus construed "consisting essentially of the following steps in the following order" simply as "comprising," the Examiner rejected the independent claims 1 and 38 under 35 USC § 103(a) for obviousness, relying on the same prior art references it was previously agreed the above quoted "consisting essentially of..." language distinguished (FSBO and Berlin).

Respectfully, these rejections are traversed. The Examiner has relied on MPEP § 2111.03 to support his construction of the above "consisting essentially of" transitional language. That section provides that "consisting essentially of" will be construed as equivalent to "comprising" where there is no "clear indication in the specification or claims of what the basic and novel characteristics actually are." This is not the case in the instant application.

As has been exhaustively argued during prosecution, the basic and novel characteristics of the invention lie in the order in which the steps are carried out. To summarize, according to the invention as claimed, *first* the seller purchases the physical

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sign at a physical location, e.g. K-Mart, then having purchased the sign, the seller logs onto a website to post the information about his good for sale. The Examiner has argued that this is inconsistent with the explicit language in claims 1 and 38; i.e. that those claims do not recite literally the words "first" carrying out step 1 and "then" or "subsequently" carrying out step 2. It is believed that such language is not necessary because the temporal order of these steps is fixed by the "consisting essentially of the following steps in the following order" language, and such additional temporal words would be redundant. However, if it will advance prosecution of this case the applicant would gladly consider adding the words "first" and "then" to the claims, to make it abundantly clear that what is being claimed, e.g. In claim 1, is a method consisting essentially of steps (a), (b), (c), and (d), performed in that order.

The Examiner has argued there is no basis in the specification to indicate what the basic and novel characteristics of the invention are. First, it is noted that the indication of what are the basic and novel characteristics of the invention can come either from the specification or from the claims themselves. See Examiner's own case cited and quoted in the last Office action:

***In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964): "...[A]bsent a clear indication in the specification or claims of what the basic and novel characteristics actually are, 'consisting essentially of' will be construed as equivalent to 'comprising.'**" (emphasis added).

Clearly, in the present claims 1 and 38, it is evident from the claim language itself that the basic and novel characteristic of the invention lies in the order of the steps; the sign must be purchased before the seller logs onto the website provided in connection with the sign to post the information regarding his good.

Second, the specification does support this order, and provides adequate basis to indicate this is the basic and novel characteristic of the invention:

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...[T]he seller, after purchasing the sign...would log onto the website, input or post information pertaining to his good for sale.... Specification, page 4 lines 11-15;

A website according to the invention is also provided...,and is designed such that the seller, having purchased the sign and following the accompanying directions, can log onto the website where he is prompted to enter certain information regarding the good for sale...as well as his contact information. Specification, page 5 lines 22-28.

In sum, the specification describes a method of marketing a good wherein the seller purchases the pre-printed "For Sale" sign from a retail store, together with accompanying directions "detailing how the seller can log onto the website and enter information regarding the good for sale" (page 5, lines 12-17). All the above provides a clear indication that the basic and novel characteristic of the invention lies in the order of these steps as evidence by the fact that the sign is provided with accompanying directions, and that after purchasing the sign, and following the accompanying directions, the seller logs onto the website to post the described information.

The "consisting essentially of the following steps in the following order" language in claims 1 and 38 performs two functions. First, it fixes the temporal order of the recited steps in each of these claims, and particularly the order of the sign purchasing and website visiting steps. It is paramount of the present invention that the seller first purchase the physical sign, and then that the sign or the accompanying directions lead the seller to the website, so the seller can post the information about his good for sale. Second, the "consisting essentially of" transitional language excludes any additional method steps from the methods as claimed which would affect this basic and novel characteristic of the invention. MPEP § 2111.03. As already explained, the basic and novel characteristic of the invention lies in the order of the website visiting and sign

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purchasing steps. Therefore, a method where the seller visits the website to receive instructions on where or how to purchase the sign, prior to purchasing the sign at a physical location, is excluded from the claims.

Prior to the invention, a "For Sale" sign seller would have gone to K Mart, purchased a "For Sale" sign, placed the sign on his car, boat, etc., in his driveway, and then waited for interested parties to stop by or call. The novelty, and the whole point of the invention, is that traditional "For Sale" sign sellers, who otherwise probably would not have used the internet to advertise at all, now are provided with a convenient means of advertising their goods over the Internet, in addition or in conjunction with a traditional "For Sale" sign. In other words, the invention as claimed facilitates an e-commerce transaction by those sellers who are not comfortable enough with the Internet to advertise there in the first place. Through the invention, a prospective seller that does not himself generally use the internet as a means of gathering information can be introduced to an internet based marketing system that functions in conjunction with conventional "For Sale" sign advertising, during a routine visit to a retail store. Since an additional method step where the website is visited prior to purchasing the physical sign at a physical location would negative this benefit, it is clear how such an additional step would materially alter the basic and novel characteristic of the invention.

According to the invention, potential purchasers still may learn of the good for sale in the conventional way (simply by seeing the sign); but now they have an alternative, anonymous means of obtaining information about the good for sale, other than contacting the seller directly or walking up the driveway to take a closer look. Practically speaking, "For Sale" sign advertising is relatively unsophisticated, and many people who would visit a retail store to purchase a "For Sale" sign would not in addition post their goods on the internet. Unlike prior or conventional marketing methods offered to private sellers of goods, the method according to the invention provides an internet-

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based advertising and marketing method that is directed specifically at those people who probably would not have logged onto the internet at all, but instead chose to go to K Mart and buy a "For Sale" sign. In effect, the method of the invention opens up a whole new market for the goods of "For Sale" sign advertisers who otherwise would not have used the internet; namely the large class of people who might be interested in the good on sight, but who are not comfortable walking up the seller's driveway or calling the seller to get more information.

MPEP 2111.03 states "[i]f an applicant contends that additional steps ... in the prior art are excluded by the recitation of 'consisting essentially of,' applicant has the burden of showing that the introduction of additional steps ... would materially change the characteristics of applicant's invention." In claim 1, the "basic and novel characteristic" of the invention is that steps (b) and (c) are performed in the recited order; i.e. the seller purchases the physical sign at a retail store, and subsequently logs onto the website. Turning to the references, the introduction of a prior step in which the website is visited first to obtain information about the purchase of a physical sign, as described in FSBO, would materially affect the basic and novel characteristic of the invention because the introduction of such a step essentially would negative the basic requirement that the sign lead the seller to the website and not vice versa. According to the invention, it is the purchase of the sign that initiates the entire transaction, and leads the seller to the website to post information. Conversely, in FSBO the seller must first visit the website to gather information and purchase the sign. Thus, FSBO essentially is the opposite of the method according to claim 1 when properly construed.

Similarly, the "basic and novel characteristic" of the invention recited in claim 38 is the order of steps (b) and (c) therein; namely selling the physical sign to the seller and then the seller logging onto the website. FSBO is inapplicable to reject claim 38 for the same reasons explained above, when claim 38 is properly construed.

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New claim 41 has been added to more clearly point out the basic and novel characteristic of the invention. In this new claim, it is positively recited that the sign is provided with "directions for logging onto said website," and that the seller, "having purchased the sign and following the accompanying directions, log[s] onto said website to post said information thereon...." In claim 41, there can be absolutely no doubt that the sign and accompanying directions lead the seller (having previously purchased the sign) to log onto the website. The reverse order is necessarily excluded by the language "having purchased the sign" the seller logs onto the website. Accordingly, it is respectfully submitted new claim 41 also is independently allowable over the cited references.

In view of the above, it is respectfully submitted that claims 1, 38, and 41 now are in condition for allowance. Specifically, the language found in each of these claims, "consisting essentially of the following steps in the following order", must be construed 1) to fix the temporal order of the recited steps, and 2) to exclude additional steps that would materially alter the order of the sign purchasing and website visiting steps therein. So construed, neither FSBO nor Berlin, either alone or in combination, anticipates or makes obvious any of claims 1, 38 or 41 for reasons already of record (see Remarks in Amendment C and Amendment D filed April 7, 2003 and October 22, 2003, respectively). All other claims are dependent claims, and thus also are in condition for allowance by virtue of their dependence on one of the above claims.

Therefore, all claims now being in condition for allowance, notice to that effect is respectfully requested.

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Respectfully submitted,
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